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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/190,129	11/12/1998	JOSEPH M. CANNON	CANNON36-37-	6291

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/190,129	CANNON ET AL.	
	Examiner	Art Unit	
	Gerald Gauthier	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 3-6 and 8-14** are rejected under 35 U.S.C. 102(b) as being anticipated by Castro et al. (US 4,387,272).

Regarding **claim 1**, Castro discloses a voice messaging system (column 1, lines 9-12), comprising:

an analog telephone line interface (column 7, lines 9-11) [The analog telephone line is connected to terminal 101 and 102 of the apparatus];

a voice recorder/playback module (column 8, lines 25-31) [The phone answering machine 165 is the voice recorder/playback module];

a controller adapted to control functions of the voice messaging system (column 7, lines 36-38) [The decoder 130 controls the operation of the system];

a ring signal bypass module adapted to detect a presence of an analog non-ring signal initiated by a caller without prompt from the voice messaging system utilizing the analog telephone line interface indicating a presence of an incoming call, and to cause the voice message system to direct the incoming call to the voice recorder/playback module without an audible ring signal to announce the incoming call

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by the system (column 8, lines 14-37) [The ring detector detects an incoming telephone call, signals the confirmation tone generator, the confirmation tone generator waits for a code from the caller without prompting the caller for the code, after a few second transfers the incoming call to the answering machine 165 to record the caller message without alerting the called party for the incoming call].

Regarding **claim 3**, Castro discloses a voice messaging system as telephone-answering device (34 on FIG. 1).

Regarding **claims 4 and 8**, Castro discloses a method for allowing bypass of ring signal in a voice messaging system (column 1, lines 9-12), comprising:

receiving an analog non-ring signal initiated by a caller without prompt from the voice messaging system at an analog telephone line interface indicating a presence of an incoming call to the voice messaging system (column 7, lines 36-43) [The ring detector detects an incoming telephone call, signals the confirmation tone generator, the confirmation tone generator waits for a code from the caller without prompting the caller for the code]; and

answering the incoming call by the voice messaging system without an audible ring signal to announce the incoming call by the voice messaging system (column 8, lines 14-37) [The confirmation tone generator waits for a code, after a few second not receiving the code transfers the incoming call to the answering machine 165 to record the caller message without alerting the called party for the incoming call].

Regarding **claims 5 and 9**, Castro discloses playing an outgoing greeting message to a caller associated with the incoming call without requiring reception of any ring signal relating to the incoming call (column 8, lines 14-31); and
allowing the caller to record a voice message (column 8, lines 14-31).

Regarding **claims 6, 10 and 13**, Castro discloses allowing a caller associated with the incoming call to record a voice message without requiring reception of any ring signal relating to the incoming call (column 8, lines 14-31).

Regarding **claims 11 and 14**, Castro discloses inputting a request for a transmission of the analog non-ring signal from a calling party's telephone (column 8, lines 14-31).

Regarding **claim 12**, Castro discloses a method of allowing a calling party to bypass a ring signal in a voice messaging system of a called party, the voice messaging system including voice message memory for recording a voice message (column 1, lines 9-12), the method comprising:

providing an analog ring signal bypass module in the voice messaging system (column 7, lines 36-43) [The ring detector detects an incoming telephone call, signals the confirmation tone generator, the confirmation tone generator waits for a code from the caller].

activating the analog ring signal bypass module based on a request from the calling party without prompt from the voice messaging system (column 8, lines 14-37) [The confirmation tone generator waits for a code, the calling party sends an incomplete code without prompt from the system]; and

bypassing an audible ring signal by the voice messaging system announcing an incoming call from the calling party to the voice messaging system (column 8, lines 14-37) [The confirmation tone generator waits for a code, transfers the incoming call to the answering machine 165 to record the caller message without alerting the called party for the incoming call].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Castro in view of Koyama (US 5,894,505).

Regarding **claim 2**, Castro as applied to **claim 1** above differs from **claim 2** in that it fails to disclose the analog telephone line interface is adapted to detect a line reversal on the telephone.

However, Koyama teaches the analog telephone line interface is adapted to detect a line reversal on the telephone (column 10, lines 18-20).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Castro by adding the line reversal signal as taught by Koyama.

The modification will allow the capability of the line reversal signal such that the system would enable the caller to selectively either leaves a message or ring the called telephone.

6. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Castro in view of Borland et al. (US 6,128,382).

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Regarding **claim 15**, Castro as applied to **claim 12** above differs from **claim 15** in that it fails to disclose the request is entered by the calling party before a telephone number of the called party is dialed.

However, Borland teaches the request is entered by the calling party before a telephone number of the called party is dialed by the calling party (column 4, lines 55-59).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Castro by adding the no-ring logic unit of Borland.

The modification will allow the capability of the no-ring logic unit such that the system would enable the caller to selectively either leaves a message or ring the called telephone.

Response to Arguments

7. Applicant's arguments with respect to **claims 1-6 and 8-15** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
December 19, 2004


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